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| 10/627,449 | 07/25/2003 | Venkiteswaran Subramanian | 0113.450US | 5224 |
| 27123 | 7590 | 07/12/2006 | EXAMINER | |
| MORGAN & FINNEGAN, L.L.P. 3 WORLD FINANCIAL CENTER NEW YORK, NY 10281-2101 | | | JOHANNSEN, DIANA B | |
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1634

DATE MAILED: 07/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

DETAILED ACTION

Priority

1. Applicant's claim for the benefit of prior-filed applications under 35 U.S.C. 119(e) and under 35 U.S.C. 120 is acknowledged. The first line of the specification should be amended so as to provide the current status of application no. 09/373,333. Further, it is requested that Applicants update the status of other co-pending applications identified in the specification by application number (see, e.g., page 37 and page 49) by amending the specification to recite, e.g., "now U.S. Patent No. _____," "now abandoned," etc.

Election/Restrictions

2. Applicant's election with traverse of Group III, claims 51-54, in the reply filed on April 24, 2006 is acknowledged. The traversal is on the ground(s) that it would not place a serious burden on the examiner to search and examine all pending claims. The response notes that "Two of the four groups of art are classified in class 435" and that "To search prior art in 3 groups cannot be deemed 'undue diverse searching.'"

Applicants' arguments have been thoroughly considered but are not found persuasive. First, although Groups I and IV are both classified in class 435, the Groups have different subclassifications, and require consideration of entirely different groups of prior art references. Applicants are reminded that separate classification alone is sufficient to establish the existence of a serious burden, as separate classification "shows that each invention has attained recognition in the art as a separate subject for inventive effort, and also a separate field of search" (see MPEP 808.02). Further, as discussed in the

Restriction Requirement of March 22, 2006, the elected invention of Group III is unrelated to the invention of Group II, and requires a text search for different reagents and method steps than the inventions of Groups I and IV, as well as the consideration of different types of prior art references than these other Groups. Thus, given the separate classifications of Groups I-IV, as well as the need for a different type of search to identify the prior art most pertinent and relevant to each Group, Applicants' argument that a search of Groups I-IV would not be unduly burdensome is not persuasive.

The requirement is still deemed proper and is therefore made FINAL.

3. Claims 1-50 and 55-60 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on April 24, 2006.

Specification

4. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

Claim Objections

5. Claims 51-54 are objected to because of the following informalities: claim 51 recites "one or more herbicide" rather than, e.g., "one or more herbicides. Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

Art Unit: 1634

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 51-54 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 51-54 are indefinite because it is unclear whether the claims are drawn to a method "of acquiring or improving an herbicide tolerance activity in a parental plant cell," as set forth in the preamble of claim 51, or to a method of "screening the modified plant cell for a distinct or improved tolerance activity to one or more herbicide compared to the parental plant cell," as set forth in the final process step. It is not clear how or whether the final "screening" step actually results in achieving the objective set forth in the claim preamble. Accordingly, clarification is required.

Claim 52 is indefinite over the recitation of the limitation "the herbicide" in the first line of the claim, because there is insufficient antecedent basis for this limitation in the claims. While claim 51 refers to an "herbicide tolerance activity" and to "one or more herbicide," the claim does not refer to a single, particular "herbicide" that might constitute "the herbicide" referenced in claim 52.

Claim 54 is indefinite because it is unclear whether the claim is drawn to a method "of acquiring or improving an herbicide tolerance activity in a parental plant cell" (as set forth in the preamble of claim 51, which claim 54 further limits), or to a method of regenerating a cell into a plant, as suggested by the language of the further limitation set forth in claim 54. The language of claim 54 should be clarified, as it appears that the

Art Unit: 1634

claim is not in fact drawn to a method of "acquiring or improving an herbicide tolerance activity in a parental plant cell."

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 51-54 are rejected under 35 U.S.C. 102(e) as being anticipated by delCardayre et al (U.S. Patent No. 6,326,204 B1 [12/4/2001; filed 7/15/1998]).

The applied reference has a common assignee and common inventors with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

DelCardayre et al teach methods comprising whole genome shuffling of plant nucleic acids within plant cells (resulting in the formation of modified plant cells), followed by screening for the acquisition of herbicide resistance (see entire reference, particularly column 2, lines 45-62; column 3, lines 22-39; column 4, lines 20-35; column

Art Unit: 1634

31, line 25-column 36, line 25; and most particularly column 21, line 25-column 22, line 14). Regarding claim 52, delCardayre et al disclose, e.g., the herbicide glyphosate (see column 21, line 31). Regarding claim 53, delCardayre et al disclose the use of nucleic acids of different strains or species to achieve initial diversity between cells (see column 31, lines 40-42). Regarding claim 54, delCardayre et al teach regenerating modified plant cells into plants (see column 22, lines 3-14). Accordingly, delCardayre et al anticipate the claimed invention.


Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Diana B. Johannsen whose telephone number is 571/272-0744. The examiner can normally be reached on Monday and Thursday, 7:30 am-4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla can be reached at 571/272-0735. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1634

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Diana B. Johannsen
Primary Examiner
Art Unit 1634